

REMARKS

Claims 2-8 and 10-40 are pending in this application. Claims 7-8 and 15-16 have been allowed without the necessity of amendments. Similarly, claim 34 has been conditionally allowed if rewritten to incorporate all limitations of its base claim 23. The Examiner's indication of allowability of these claims is noted with appreciation. However, forbearance is respectfully requested, since base claims 2, 10 and 23 and their respective dependent claims 3-6, 11-14, 17-22 and 24-40 are believed to be distinguishable over the cited prior art. As a result, no claim has been amended herein.

As a preliminary matter, Applicants appreciate the withdrawal of the previously outstanding rejection of claims 2-3, 10, 17-19, 21-34 and 37 under 35 U.S.C. §102(e) as being anticipated by Sawada et al., U.S. Patent Application Publication No. 2001/0021663.

However, claims 2-4, 6, 10, 12, 14, 17-33 and 36-40 have been newly rejected under 35 U.S.C. §103(a) as being unpatentable over Sawada et al., U.S. Patent Application Publication No. 2001/0021663, as modified to incorporate selected features from a newly cited art, Arnold, U.S. Publication No. 2001/0044330 for reasons stated on pages 2-5 of the final Office Action. In support of the rejection of base claims 2, 10 and 23, the Examiner asserts that Sawada '663, as a primary reference, discloses Applicants' claimed "electronic apparatus" comprising:

"an electronic device including a body (see 21, fig. 8); and

a battery (22) coupled to the body to supply current to said electronic device, said battery further comprising a memory unit (42, 43, fig. 8) to store information (see par. 0041, 0055).

Where said battery comprises a primary power connector to connect to said electronic device to supply current to said electronic device (see par. 008, 013-014)."

However, the Examiner admits that Sawada '663 fails to disclose that the battery further comprises "a secondary power output port to connect to another device having a controller to supply current thereto to power the controller". Nevertheless, the Examiner cites FIG. 5D, paragraphs [0010], [0012] and [0037] of the newly cited art, Arnold '330 for allegedly disclosing such features.

The Examiner's newly formulated assertions are factually incorrect. Applicants note that features as relied by the Examiner are **not** disclosed or suggested by Arnold '330, and request

the Examiner to reconsider and withdraw this rejection for the following reasons.

Base claims 2, 10 and 23 expressly define that the battery for an electronic device is not only incorporated with (1) a primary power connector used to power the electronic device, but is also provided with (2) a secondary power output port 211, as shown, for example, in FIG. 2, FIG. 3, FIGs. 4A-4B and FIG. 6. Such a battery is used to advantageously allow connection with another [electronic] device having a controller to supply current thereto to power the controller [of the another electronic device]," as shown in FIG. 6. This way the same battery can advantageously serve as a power source to at least two different electronic devices, that is, an electronic device in which it is attached to and intended for operation, and another, i.e., a different electronic device 300, such as a portable phone, a notebook computer or a PDA, as shown in FIG. 6, particularly, in the event where information contained in the memory unit of the battery needs to be shared or exchanged with the another electronic device 300. As a result, power from the same battery can be provided to, or shared by different electronic devices at the same time.

Specifically, base claim 2 defines a battery as comprising, *inter alia*:

a memory unit to store information, a primary power connector to connect to said electronic device to supply current to said electronic device, and a secondary power output port arranged to receive insertion of a power cable of another device different from said electronic device and external to the battery to supply power to a controller of the another device.

Similarly, base claim 10 defines a battery for an electronic device, comprising, *inter alia*:

a memory unit to store information;
 a battery unit to store energy and which is connected to said memory unit;
 a **primary power connector** arranged to connect to the electronic device to power the electronic device; and
 a **secondary power output port** arranged to receive insertion of a power plug of another device to supply current thereto to power a controller of the another device different from the electronic device,
 wherein the battery is detachable from the electronic device, and
 wherein the another device is external and detachable from the battery.

In contrast to Applicants' base claims 2, 10 and 23, Sawada '663, as a primary reference, simply discloses the use of a battery pack, as shown in FIG. 2 and FIG. 4, including a battery for supplying electric power.

Specifically, Sawada '663 discloses the use of a battery pack 22, as shown in FIG. 1 (1st

embodiment), FIG. 5 (2nd embodiment), and FIG. 9 (3rd embodiment) for supplying a single electronic apparatus, such as a wireless telephone set, a PDA, and a camera, with electric power which can protect data stored in memories such as an IC card from being broken or lost. In both FIG. 5 (2nd embodiment) and FIG. 9 (3rd embodiment), the battery pack 22 is further built in a reproducing device 23 or 54 which is a music playback device used to transmit a radio signal of audio data to the portable telephone unit 21 or 51. However, since the reproducing device 23 or 54 is built inside the battery pack 22, the reproducing device 23 or 54 is automatically powered by the battery pack 22. There is no need for such a battery pack 22 to include any power output port, which is commonly used to supply to an external device, via a power cable.

As a secondary reference, Arnold '330 does not remedy the noted deficiencies of Sawada '663 in order to arrive at Applicants' base claims 2, 10 and 23. This is because Arnold '330 only discloses removable modules to be placed on the back of a portable communication device, such as a cellular phone. Specifically, these removable modules may include a battery extension pack 40, as shown in FIG. 1 and FIGs. 5A-5DF, used to supply voltage to the communication device 5 or to recharge a battery 25 inside the communication device 5. In addition, or instead of a battery extension pack 40, these removable modules may also include a system connector pack 60, as shown in FIGs. 6A-6D, and FIG. 7, used for data transmission or additional battery charging functions, via a flexible system cable 65.

However, a groove 125 has to be provided in the backplate 20 of the communication device 5, as shown in FIGs. 5A-5D, in order to receive the battery extension pack 40 and the system connector pack 60. Likewise, a system connector 70 has to be built-in to the backplate 25 and bonded to the internal circuit board 15 of the communication device 5, in order to receive the corresponding interface connector 140 on the battery extension pack 40 or the corresponding interface connector 135 on the system connector pack 60. As succinctly described in paragraph [0035] of Arnold '330,

"[T]he system connector 70 shown in FIG. 2A may be used for a variety of functions. For example, in one preferred embodiment, the connector 70 may be used to recharge the battery 25 within the hinge of the device 5. Examples of battery cells include Lithium Ion... The system connector 70 may also be used to transfer data to a laptop computer or other device and to provide an external antenna. Other functions of an external connector are known in the art."

In other words, both the groove 125 and the system connector 170 are used to make the communication device 5, such as a cellular phone, well suited for cradle mounting. Once the battery extension pack 40 and the system connector pack 60 are mounted on the backplate 20 of the communication device 5, these removable modules can be inserted into the system connector 70, via an interface connector 135 or 140, to either recharge a battery 25 within the communication device 5, or to transfer data to a laptop computer or other device.

However, there is absolutely **no** disclosure anywhere from Arnold '330 of Applicants' claimed "battery" comprising "a secondary power output port to connect to another device having a controller to supply current thereto to power the controller" as mistakenly believed by the Examiner. Nevertheless, the Examiner cites FIG. 5A, paragraphs [0010], [0012] and [0037] of Arnold '330 for allegedly disclosing such features. However, the Examiner's citation is misplaced.

Specifically, the cited paragraph [0010] of Arnold '330 simply reiterates the use of these removable modules, such as a battery extension pack 40, or a system connector pack 60, adapted to transfer data from the communication device 5 to another device, or to recharge a battery inside the communication device 5. Similarly, the cited paragraph [0012] of Arnold '330 simply refers to the stackability of these removable modules.

Likewise, the cited paragraph [0037] of Arnold '330 describes the coupling of an interface connector of a battery extension pack 40 relative to a system connector 70 on the backplate 20 of the communication device 5.

Again, Arnold '330 does **not** disclose or suggest any thing relating to Applicants' claimed "battery" comprising "a secondary power output port to connect to another device having a controller to supply current thereto to power the controller" as expressly defined in each of Applicants' base claims 2, 10 and 23.

In order to establish a *prima facie* case of obviousness under 35 U.S.C. §103, the Examiner must show that the prior art reference (or references when combined) must teach or suggest all the claim limitations, and that there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings, provided with a reasonable expectation of success, in order to arrive at the Applicants' claimed invention. The requisite motivation must stem from some teaching or suggestion to make the claimed combination must

be found in the prior art, and **not** based on Applicants' disclosure. In re Vaeck, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991). See MPEP 2143. In other words, all the claim limitations must be disclosed or suggested by the prior art. In re Royka, 490 F.2d 981, 180 USPQ 580 (CCPA 1974). Moreover, "obviousness cannot be established by combining the teachings of the prior art to produce the claimed invention, absent some teaching, suggestion or incentive supporting the combination." ACS Hospital System, Inc v. Montefiore Hospital, 732 F.2d 1572, 1577, 221 USPQ 929, 933 (Fed. Cir. 1984). The Examiner must point to something in the prior art that suggests in some way a modification of a particular reference or a combination of references in order to arrive at Applicants' claimed invention. Absent such a showing, the Examiner has improperly used Applicants' disclosure as an instruction book on how to reconstruct to the prior art to arrive at Applicants' claimed invention. Furthermore, any deficiencies in the cited references cannot be remedied with conclusions about what is "basic knowledge" or "common knowledge". In re Lee, 61 USPQ 2d 1430 (Fed. Cir. 2002).

In the present situation, both Sawada '663 and Arnold '330 fail to disclose and suggest key features of Applicants' base claims 2, 13 and 23. Therefore, Applicants respectfully request that the rejection of base claims 2, 13 and 23 and their respective dependent claims be withdrawn.

Dependent claim 11 has been rejected under 35 U.S.C. §103(a) as being unpatentable over Sawada '663 in view of Arnold '330 and further in view of Gilbert, U.S. Publication No 2001/003205 for reasons stated on pages 5-6 of the final Office Action. Dependent claims 5 and 13 have been rejected under 35 U.S.C. §103(a) as being unpatentable over Sawada '663 in view of Arnold '330 and Griffith et al., U.S. Patent No. 6,917,280 for reasons stated on page 6 of the final Office Action. Dependent claim 35 has been rejected under 35 U.S.C. §103 as being unpatentable over Sawada '663 in view of Arnold '330 and SanGiovanni, U.S. Publication No. 2002/0102946 for reasons stated on page 6 of the Office Action. In response thereto, Applicants respectfully traverse these rejections at least for the same reasons as discussed above, noting that none of these references discloses or suggests Applicants' claimed "secondary power output port arranged to receive insertion of a power cable of another device different from said electronic device and external to the battery to supply power to a controller of the another device" as defined in base claims 2 and 10. Moreover, since these rejections are predicated upon the correctness of the rejection of Applicants' base claims 10 and 23, which Applicants have demonstrated as being incorrect, Applicants respectfully request that these

rejections be withdrawn for the same reasons discussed.

In view of the foregoing amendments, arguments and remarks, all claims are deemed to be allowable and this application is believed to be in condition to be passed to issue. Should any questions remain unresolved, the Examiner is requested to telephone Applicants' attorney at the Washington DC office at (202) 216-9505. Applicants respectfully reserve all rights to file subsequent related application(s) (including reissue applications) directed to any or all previously claimed limitations/features which have been amended or canceled, or to any or all limitations/features not yet claimed, i.e., Applicants have no intention or desire to dedicate or surrender any limitations/features of the disclosed invention to the public.

INTERVIEW:

In the interest of expediting prosecution of the present application, Applicants respectfully request that an Examiner interview be scheduled and conducted. In accordance with such interview request, Applicants respectfully request that the Examiner, after review of the present Amendment, contact the undersigned local Washington, D.C. area attorney at (202) 216-9505 for scheduling an Examiner interview, or alternatively, refrain from issuing a further action in the above-identified application as the undersigned attorneys will be telephoning the Examiner shortly after the filing date of this Amendment in order to schedule an Examiner interview. Applicants thank the Examiner in advance for such considerations. In the event that this Amendment, in and of itself, is sufficient to place the application in condition for allowance, no Examiner interview may be necessary.

Please charge any shortage of fees due in connection with the filing of this paper, including any extension of time fees under 37 CFR §1.136, to the Deposit Account of Stein, McEwen & Bui, LLP, No. 503333 (Application No. 1293.1290), and please credit any excess fees to said deposit account.

Respectfully submitted,

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